

Docket No. 231036US0

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Xavier BLIN, et al.

SERIAL NO: 10/687,581

GAU: 1617

FILED: October 20, 2003

EXAMINER:

FOR: COMPOSITION CONTAINING AN OILY PHASE AND A NAPHTHOPYRAN DYE, COSMETIC TREATMENT PROCESSES

INFORMATION DISCLOSURE STATEMENT UNDER 37 CFR 1.97

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicant(s) wish to disclose the following information.

REFERENCES

- ☒ The applicant(s) wish to make of record the references cited on the attached Japanese Office Action Statement of Relevancy and listed on the attached form PTO-1449. Copies of the listed references are attached, where required, as are either statements of relevancy or any readily available English translations of pertinent portions of any non-English language references.
- ☐ A check or credit card payment form is attached in the amount required under 37 CFR §1.17(p).

RELATED CASES

- ☐ Attached is a list of applicant's pending application(s), published application(s) or issued patent(s) which may be related to the present application. In accordance with the waiver of 37 CFR 1.98 dated September 21, 2004, copies of the cited pending applications are not provided. Cited published and/or issued patents, if any, are listed on the attached PTO form 1449.
- ☐ A check or credit card payment form is attached in the amount required under 37 CFR §1.17(p).

CERTIFICATION

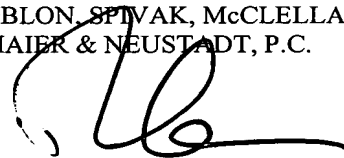
- ☐ Each item of information contained in this information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this statement.
- ☐ No item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the undersigned, having made reasonable inquiry, was known to any individual designated in 37 CFR §1.56(c) more than three months prior to the filing of this statement.

DEPOSIT ACCOUNT

- ☒ Please charge any additional fees for the papers being filed herewith and for which no check or credit card payment is enclosed herewith, or credit any overpayment to deposit account number 15-0030. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
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DOCKET NO: 231036US0



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
XAVIER BLIN, ET AL. :
SERIAL NO: 10/687,581 :
FILED: OCTOBER 20, 2003 : GROUP ART UNIT: 1617
FOR: COMPOSITION CONTAINING AN :
OILY PHASE AND A NAPHTHOPYRAN
DYE, COSMETIC TREATMENT
PROCESSES

JAPANESE OFFICE ACTION

STATEMENT OF RELEVANCY

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Summary of Japanese Official Action

Examiner cited the following nine citations, and argued that the claims 1-32 are not novel over Citations 1-2 (Reason 3) or not inventive over Citations 1-2 or 1-9 (Reason 4):

Citation 1: JP-A 2000-038329
Citation 2: JP-A H10-147776
Citation 3: WO 02/36083
Citation 4: JP-T 2001-518927
Citation 5: US-A1 2002/0122780
Citation 6: JP-T 2001-518926
Citation 7: JP-T 2001-518893
Citation 8: JP-T H08-508290
Citation 9: WO 99/31081

Examiner raised a clarity objection to Claims 1, 3-9, 11-17, and 24-26 and Claims 12-15 and 28 (Reason 1), and an enablement objection to Claims 12-15 (Reason 2).

Reason 1 (Clarity Objection):

(i) The Examiner argued as follows:

A-1) Claims 1, 3-9, 11-17 and 24-26

The recitations of "preferably", "especially" and "for example" in the above claims are expressions that make the features for specifying the invention ambiguous, and therefore make the scope of the invention unclear.

A-2) Claims 12-15 and 28

While the above claims specify parameters of compositions, it is not clear specifically what is included and not included among compositions having such parameters, as a result of which the features for specifying the invention are unclear.

Reason 2 (Enablement Objection):

(i) Regarding Claims 12-15, the Examiner argued as follows:

The original specification of the present application does not indicate any compositions that fulfill the parameters recited in the above claims, and those skilled in the art would not have been capable of conceiving of such compositions even with reference to the common knowledge in the art at the time the application was filed; additionally, the working of the invention recited in these claims requires trial and error exceeding the level capable of being expected from those skilled in the art in order to enable confirmation of whether innumerable compositions agree with said parameters, so that the detailed description of the invention of the present application fails to clearly and adequately describe the present invention to such a degree as to enable those skilled in the art to work the invention.

Reasons 3 & 4 (Novelty & Obviousness Rejections):

(i) The Examiner argued as follows:

Citations 1 and 2 (see claims and examples) describe cosmetic compositions containing photochromic organic dyes and solvents corresponding to Chemical Formula 1 of the present application, and there is no difference in the features for specifying the invention between the present invention and the inventions described in these citations.

(iii) The Examiner further argued as follows:

Citations 1-3 (see claims and examples) describe cosmetic compositions containing photochromic organic dyes and solvents, and those skilled in the art could have easily chosen those that are publicly known as described in Citations 4-9 as the photochromic dyes. Additionally, those skilled in the art could have readily tried adding various publicly known ingredients to experimentally optimize the amounts of the various ingredients and employing publicly known formats.

Form PTO 1449
(Modified)U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICEATTY DOCKET NO.
231036US0SERIAL NO.
10/687,581

LIST OF REFERENCES CITED BY APPLICANT

APPLICANT
Xavier BLIN, et al.FILING DATE
October 20, 2003GROUP
1617

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
	AA						
	AB						
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION	
					YES	NO
	AL	2000-038329	02-08-00	JAPAN w/Attached English Abstract		X
	AM	WO 02/36083	05-10-02	WIPO		
	AN	WO 98/42695	10-01-98	WIPO (Corresponds to JP 2001-518927)		
	AO	WO 98/42693	10-01-98	WIPO (Corresponds to JP 2001-518926)		
	AP	WO 98/45281	10-15-98	WIPO (Corresponds to JP 2001-518893)		
	AQ	WO 99/31081	06-24-99	WIPO		
	AR	WO 94/22850	10-13-94	WIPO (Corresponds to JP 08-508290)		
	AS	10-147776	06-02-98	Japan w/Attached English Abstract		X
	AT	2001-518893	10-16-01	Japan w/Attached English Abstract		X
	AU	2001-518926	10-16-01	Japan w/Attached English Abstract		X
	AV	2001-518927	10-16-01	Japan w/Attached English Abstract		X

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, etc.)

	AW	
	AX	
	AY	
	AZ	

☐ Additional References sheet(s) attached

Examiner

Date Considered

*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.